

Appln No.: 10/604,166  
Amendment Dated: April 4, 2006  
Reply to Office Action of January 4, 2006

#### REMARKS/ARGUMENTS

This is in response to the Office Action mailed January 4, 2006 for the above-captioned application. Reconsideration and further examination are respectfully requested.

As a first matter, Applicants note that the basis for much of the present action is an assertion that the evidence in the application is insufficient to overcome the assertion of obviousness over the cited references. It is pointed out, however, that the Examiner did not make these arguments in the first instance because of **Patent Office error** in printing the electronically filed application which led to the evidence of non-obviousness being missing from the application. In these circumstances, stating that the evidence in the application is not sufficient in a **final action** is improper, and the finality of the action should be withdrawn. **If the finality of the rejection is withdrawn, Applicants request leave to add additional dependent claims prior to the issuance of a further action on the merits as reflected in the attached appendix.**

Claims 24 has been amended to add the word "about" in view of the examiner contention that omission of the term constituted new matter.

The Examiner rejected claims 1-23 for obviousness-type double patenting in view of claims 1-4 and 20-26 of US Patent No. 6,353,046 in view of US 5,606,007 and 6,136,945. In response to Applicants argument that this rejection is improper because all of the references relied upon are available as art under 35 USC § 102(b), the Examiner stated that the rejection would be maintained in the absence of case law saying it was in error. To Applicants' knowledge, there is no case law addressed to this point, because it has never been necessary to proceed to a formal decision on an argument that makes no logical sense in the context of the reasons for judicially created obviousness-type double patenting.

As pointed out in the Examiner's own form paragraph, the purpose of the nonstatutory double patenting is "to prevent the unjustified or improper timewise extension of the 'right to exclude' ... and to prevent possible harassment by multiple assignees." The Examiner has offered no reasons why issuing a new patent that is not anticipated by nor obvious over a patent which is § 102(b) prior art could possibly give rise to anything that is **unjustified or improper**. Further, the Examiner has offered no law that supports the proposition that this doctrine can be used to place the present inventors in a worse position than a third party making the same claims in terms of patent terms and rights of assignments. Accordingly, the rejection should be withdrawn.

The Examiner rejected claims 1-25 under 35 USC § 102(b) or 103 as anticipated by or obvious over Rosenquist in view of Sakshita and Mestanza. Applicants traverse this rejection.

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Looking first at the assertion of anticipation over Rosenquist, Applicants point out that for there to be anticipation, a single reference must teach each and every element of the claimed invention. Furthermore, in an anticipation rejection, "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990).

The Examiner in the previous action did not do this, and he still has not. In the previous response, Applicants pointed out that the Examiner has not shown where in the references there was a teaching of the base to quencher ratio as set forth in the present claims. The Examiner now states that Example 1 of Sakashita teaches a molar ratio of 5. Sakashita, however, is not the reference that the Examiner alleges is anticipatory and therefore the examiner still has not identified where in the Rosenquist reference there is a teaching of each and every element of the claimed invention. Accordingly, the Examiner has not met his burden and the rejection under 35 USC § 102 should be withdrawn.

With respect to the 103 rejection, the Examiner asserts that the data in the tables in the application is not convincing because (1) some of the examples allegedly are not superior, and (2) because the base and acidic quencher of the claims are broader than the actual showing of the examples. Applicants respectfully disagree with these arguments.

The Examiner's first argument is based on the observation of a UL rating of V2 in Batch 4 in Table 2 when the phosphorous acid ratio is 30.5 or a V0/V1 in Batch 3 when the ratio of 18.5. While claim 1 recites a ratio of 1 to 30, it does not mean that the composition of Batch 4 falls within the scope of the claims, because claim 1 also states that "components (a) and (b) work in combination such that the composition achieves a V0 UL flammability rating at a thickness of 2 mm and has a haze of no more than 1%." Given the teaching of the specification, including in particular that of Batches 3 and 4 in Table 2, the person skilled in the art would understand that the amounts of the two components cannot exceed a threshold amount in order to meet this limitation, and that this amount will be different (not always as high as a ratio of 30) depending on the quencher used.

Applicants further point out that when the quencher is specifically identified in the claims as phosphorous acid, the molar ratio is also specified as a molar ratio of 1 to 15 with respect to the initial base catalyst. (claims 7, 9, 13, 15, 21 and 23). Plainly this argument cannot be of relevance with respect to these claims.

The second argument raised by the Examiner is that the base and acidic quencher in the claims are broader than those in the test results. While case law establishes that the evidence of unexpected results must be commensurate in scope with the claims, this does not mean that evidence must be presented with respect to every possible embodiment. Rather what is required

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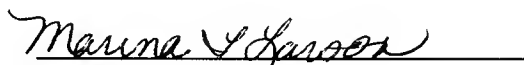
is a showing that a person skilled in the art would consider representative. The Examiner has offered no reasons why the examples employed are not deemed representative, and therefore Applicants are at a loss as to know what deficiency the Examiner perceives.

It is noted that the Examples make use of two very different acid quenchers. Phosphorous acid is a Bronsted acid because it can act as a proton donor. The tosylate on the other hand is a Lewis acid, which can donate an electron pair, but which has no proton to donate. In these circumstances, there is no apparent basis for an assertion that these two species are not representative of the class of acid quenchers as claimed.

With respect to the catalysts, there are two claim limitations presented. Claim 1 says that the catalyst is a basic catalyst for a melt esterification reaction. Claim 2 says that the catalyst is a sodium salt. The catalyst used in the examples is sodium hydroxide, which is the prototypical basic catalyst. Basic catalysts are well known in the relevant art, and are generally considered as interchangeable since all work as catalysts because they are basic. The interaction between the catalyst and the quencher is an interaction between an acid and a base that results in neutralization of the base. This reaction is understood to be independent of the nature of both the acid and the base.

Given these factors, the Examiner has offered no reasoning why the examples tested are not commensurate in scope with the claims. Applicants request either clarification or withdrawal of the rejection.

Respectfully submitted,



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Attachment:  
Appendix of proposed claims

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**Proposed Claims**

26. (proposed)           The composition of claim 2, wherein the basic catalyst is sodium hydroxide.
27. (proposed)           The composition according to claim 26, wherein the acidic quencher is butyl tosylate at a level of 1 to 10 ppm.
28. (proposed)           The composition according to claim 26, wherein the acidic quencher is phosphorous acid at a molar ratio of 1 to 15 with respect to the initial base catalyst.